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In re Application of: Park, et al.
Appl. No.: 10/669,747
Filed: 25 September 2003
For: A Packing Crate

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: DECISIONS ON PETITIONS
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This is responsive to the petitions filed on 1) December 2, 2004 by which petitioners request supervisory review of the Examiner's failure to acknowledge the filing and receipt of the certified Korean priority application No. 2003-52691; 2) October 27, 2005 by which petitioners request supervisory review of the Examiner's failure to provide a complete non-final Office action by not citing U.S. Patent No. 3,850,362 on form USPTO-892; and 3) November 1, 2005 by which petitioners request supervisory review of the restriction requirement rendered in paper No. 20050524 mailed May 31, 2005, traversed by petitioners on June 9, 2005 and finalized by the Examiner in paper No. 20050904 mailed September 9, 2005. These petitions are considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition filed on December 2, 2004 is granted.

Review of the application prosecution history reveals that the relief requested by the petitioners was in fact satisfied in the subsequent Office action, paper No. 20041112, mailed on November 17, 2004.

The petition filed on October 27, 2005 is denied.

In accordance with the MPEP, section 710.06, when an applicant's ability to respond to an Office action is impaired by the lack of a proper reference citation, the period for response will be extended. Here, since the Stollberg et al. reference - Patent No. 3,850,362 - was cited in the body of the Office action, Applicant could have easily accessed the reference through the use of PAIRS, and responded to the Office action within the set statutory period for response. The oversight on the part of the Examiner is considered a mere formality in this case that should not have affected the line of communication between Applicant and the Examiner.

For petitioners' convenience, a copy of section 710.06 of the MPEP is reproduced hereinbelow.

710.06 [R-3] Situations When Reply Period Is Reset or Restarted

Where the citation of a reference is incorrect or an Office action contains some other *>error that affects applicant's ability to reply to the Office action< and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2-month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected. See MPEP § 707.05(g) for the manner of correcting the record where there has been an erroneous citation.

The petition filed on November 1, 2005 is granted.

On November 17, 2004, the Examiner rendered a first Office action (paper No. 20041112) rejecting originally filed claims 1-18. On March 14, 2005, Applicants responded by filing an amendment amending certain claims, cancelling claim 10 and adding new claims 19-21. On May 31, 2005, the Examiner rendered a written restriction requirement (paper No. 20050524) between claims 1-18, not addressing cancelled claim 10, nor newly added claims 19-21. On June 9, 2005, Applicants traversed the restriction requirement. On September 9, 2005, the Examiner rendered a non-final Office action (paper No. 20050904) wherein the restriction requirement was made final.

The petitioners opine that the restriction requirement was improperly imposed for several reasons.

Firstly, the petitioners rely on the MPEP section 811, which states:

811 [R-3] Time for Making Requirement

37 CFR 1.142(a), second sentence, **>indicates that a restriction requirement "will normally< be made before any action upon the merits; however, it may be made at any time before final action **." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

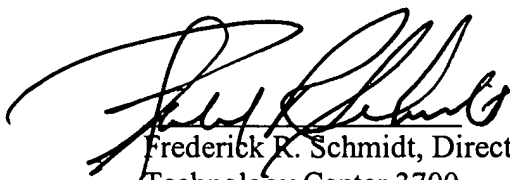
Although a restriction requirement could be made any time before final, the Examiner rendered a first Office action on all the claims presumed to be thoroughly searched in all the appropriate areas. Since no indication on the record was made of how a serious burden exists by having to examine all the claims, the Examiner has not met the requirements for making a restriction in this case. Referring to the reasons given in paper No. 20050904, the Examiner states, "it is noted method claims is required further required to be searched in class 493. Thus, this would have a serious burden on the examiner." The title of class 493, subclass 84 where the examiner classified the method claims is "Container making – assembling distinct members". This and other subclasses (e.g., 121, 136 and particularly 140) appear to be very pertinent searches in determining the patentability of the method as well as the product claims. For this reason alone, the restriction requirement is improper and will be withdrawn.

Secondly, petitioners contend that MPEP 806.03 mandates that a patent application must never be restricted when only a single embodiment is disclosed and claimed. In the instant case, there is only one packing crate described and claimed by a series of product-by-process claims and method of making claims, which would be restrictable if the criteria for distinctness therebetween could be properly satisfied. In this case, the Examiner has not satisfied such criteria. In the Office action of paper No. 20050524, the Examiner states "In the instant case, the product as claimed can be made by other methods, the sewing can be done by hand, or before the application of adhesive as set forth in claims 7, 8 or 9." However, the process as claimed does not require any specific method of sewing. Also, it would be impossible to apply adhesive to the folded over portion of the first stack after it has been sewn to the second stack. Claim 8 clearly calls for the sewing to be done after the application of adhesive. Therefore, since the Examiner has not satisfied the criteria for distinctness, the restriction requirement is improper and will be withdrawn.

For the reasons outlined above, the restriction requirement promulgated and construed as being made final is not in accordance with proper Office procedure. Accordingly, the Office action rendered in paper No. 20050904 is hereby vacated.

As a further procedural note, as this petition grants Petitioner relief from the restriction requirement, the amendment presented June 9, 2005 is deemed responsive to which a new Office action will be rendered. The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3727 who will have the examiner promulgate an action on the merits of the presently pending claims not inconsistent with this Decision.

PETITION GRANTED



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